

the original documents from which the Notarial Confirmation extracted the information have now been filed with the PTO for recording on this date. A copy of the cover sheet with the documents is enclosed herewith for the Examiner's information.

The Examiner rejected Claims 11-30 under 35 U.S.C. § 251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner asserted that the "broadening aspect" in the reissue relates to subject matter previously surrendered during the prosecution of the original application. Specifically, the examiner said, "Claims must include all the structure from original claim 3 in grandparent 08/371,210 to avoid recapture. The "ring supporting surface" of the housing does not appear in claims 11-30. This rejection is respectfully traversed.

Original Claim 3 of the grandparent application read:

The device of claim 2, wherein said housing has a ring supporting surface, said end portions of the housing and the cap having such axial dimensions that a play is retained between their mutually facing surfaces when said ring abuts said engaging portion of the cap and the peripheral portion of said ring abuts said supporting surface.

Thus, Claim 3 essentially had two limitations:

1. said housing has a ring supporting surface; and
2. said end portions of the housing and the cap having such axial dimensions that a play is retained between their mutually facing surfaces when ....

In the Office Action of June 2, 1995, the Examiner rejected Claims 1, 2, and 4 under 35 U.S.C. § 102(b) as

anticipated by a reference (U.S. Patent No. 3,815,787) to Spies. The Examiner explained:

Spies shows a device for emptying a tube (14) comprising a ring (50), housing (16), a piston (40), cap (64), dispensing opening (92), annular engaging portion (70) and supporting surface (24). [Emphasis added.]

At the same time, the Examiner indicated the allowability of Claim 3.

As the Examiner correctly pointed out in the Action, recapture occurs when an applicant attempts to obtain in a reissue claims which were cancelled or otherwise relinquished during prosecution of the original patent. It is clear from the case law that an applicant may not omit a limitation which was relied upon for patentability. See e.g., *Hester Industries Inc. v. Stein Inc.*, 46 USPQ2d 1641 (Fed. Cir. 1998); *Ball Corp. v. United States*, 221 USPQ 289 (Fed. Cir. 1984); and *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997).

It is clear that it was limitation 2 which was relied upon for patentability and not limitation 1. In the Office Action of June 2, 1995, the same Examiner said that the prior art Spies reference teaches a "supporting surface (24)". Thus, that limitation was not relied upon for patentability and may, under the prevailing case law, be omitted. At the interview, The Examiner agreed.

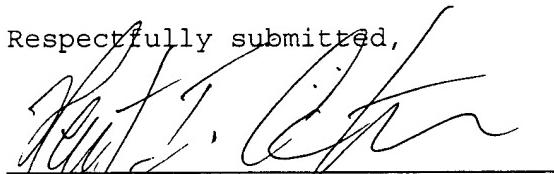
The Examiner pointed out that the Reissue Declaration is defective because it does not include the foreign priority claimed in the original patent. Applicants are pleased to

enclose the executed Supplemental Reissue Declaration herewith.

Since all the claims are clearly in condition for allowance and are free of the prior art, an early Notice of Allowance is in order and the same is most earnestly solicited. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of time sufficient to effect a timely response and any necessary fees be charged, or any overpayment in fees be credited, to the Deposit Account of Evenson, McKeown, Edwards & Lenahan, Account No. 05-1323 (Docket No. 1860/48111RE).

Respectfully submitted,



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